Examiner White first discussed how they were in agreement that, as stated in the January 2, 2002 Office Action, the "prior art slot machines do not have single symbol re-spin and replacement features." Applicant's attorney and Examiner White then discussed how the claims could be amended to reflect that agreement.

B. Formal Matters

Applicant's "Abstract of the Disclosure" has been objected to as exceeding 150 words. Even though Applicant's "Abstract of the Disclosure" is essentially identical to that published in Applicant's parent U.S. Patent No. 5,704,835, Applicant has nonetheless edited his present "Abstract of the Disclosure" in compliance with the Examiner's request, so that it now has fewer words.

Claims 15 and 16 have been objected to because they depend from canceled claim 14. To overcome this basis of objection, Applicant has amended claims 15 and 16 so that they now depend from pending claim 13 instead.

B. Prior Art Rejections

1. The Invention

Applicant has invented a variation of the popular electronic slot machine game in which up to all of the electronically generated symbols arrayed in multiple symbol columns and rows can be individually replaced after an initial array of symbols is generated. An apparatus to implement Applicant's electronic slot machine game preferably includes a monitor for displaying the array of symbols, a memory which stores a list of possible symbols, a microprocessor to select symbols from the memory, a first switch to initiate game play and a second switch to allow for replacement of selected symbols. In one alternative embodiment, both the symbols and their background colors can be replaced to add further variability and enjoyment to the game.

2. The Cited Art Distinguished

Claims 1-13, 15-17, 31, 33 and 35 have again been rejected under 35 U.S.C. § 103(a) as being obvious over Dabrowski's U.S. Patent No. 5,356,140 ("Dabrowski patent") in view of Manship's U.S. Patent No. 5,393,061 ("Manship patent"). As noted by the Examiner, the Dabrowski patent discloses a video *poker* game. In the Dabrowski poker game, two poker hands are simultaneously dealt with one hand superimposed upon the other. The player then chooses which hand to play and "the unselected hand is voided or removed from use" (Dabrowski patent abstract). Applicant's invention is not directed to a video poker game, but rather a variation of the popular electronic slot machine. To make this point clear, Applicant has stated in each of his claims 1-30 that the monitor displays a plurality of symbols "arrayed in separate boxes of multiple symbol columns and rows" and stated in claims 31-36 that the monitor displays a plurality of symbols "arrayed in multiple symbol columns and rows." Moreover, to illuminate other common differences between video slot machines and video poker games to thereby provide alternative grounds for allowance, Applicant has stated in claims 31-36, respectively, that a winning combination is determined by assessing "whether particular symbols are aligned horizontally, vertically, diagonally or in another geometric pattern which matches a predetermined winning combination" (claims 31-32), that a "simulated spinning motion" is made before symbols are displayed (claims 33-34) and that the symbols are arrayed "so as to appear to be on a plurality of vertical reels" (claims 35-36).

The Dabrowski video poker game, like other video poker games, does not have a plurality of symbols "arrayed in multiple symbol columns and rows," much less in "separate boxes" in these multiple symbol columns and rows (claims 1-30). Instead, Dabrowski shows only a single row of superimposed cards at the beginning of the game which quickly becomes simply a single row of individual cards as the game is played. Moreover, unlike slot machine games, the winning combination in Dabrowski is not determined by "assessing whether particular symbols are aligned horizontally, vertically, diagonally or in another geometric pattern which matches a predetermined winning

combination" (claims 31-32), there is no "simulated spinning motion" made before symbols are displayed (claims 33-34) and symbols are not arrayed "so as to appear to be on a plurality of vertical reels" (claims 35-36). As such, since the Dabrowski patent discloses an entirely different game than that being claimed by Applicant, the Dabrowski patent does not teach the subject matter of Applicant's claims.

To show the existence of a game in which symbols are displayed in multiple rows and columns, the Examiner cites the Manship patent. For his part, Applicant does not dispute that electronic slot machine games, of the type shown in the Manship patent, have been in use for many years. What Applicant does dispute is that, prior to Applicant's invention, electronic slot machine games were known which allowed the type of individual symbol replacement capabilities disclosed and claimed by Applicant (see, Jan. 10, 2001 Dietz Decl., ¶ 2). The Manship patent certainly fails to disclose any such individual symbol replacement capabilities. Moreover, neither the Examiner for Applicant's issued patent, U.S. Patent No. 5,704,835, nor the present Examiner has been able to find any electronic *slot machine* prior art reference with such disclosure.

Given the enormous popularity of slot machine gaming, if it were so "obvious" to add individual symbol replacement capability to an electronic slot machine game, it would have been done long before Applicant's invention. *See In re Dembiczak,* 175 F.3d 994, 999 (Fed.Cir. 1999)("the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"). The fact that there is no such prior art and Applicant's competitors have now been quick to copy Applicant's invention provides strong "secondary consideration" support for a finding of non-obviousness (Jan. 10, 2001 Dietz Decl., ¶ 2-4). *In re Beattie*, 974 F.2d 1309, 1313 (Fed.Cir. 1992)(secondary consideration evidence "may be sufficient to overcome a prima facie case of obviousness"). For these reasons, the Examiner's proposed combination of the Dabrowski and Manship patents would not render as "obvious" the subject matter of Applicant's claims.

Claims 18-19 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Dabrowski patent in view of either the Manship patent or Bennett's U.S. Patent No. 6,056,642 ("Bennett patent"). With respect to the Dabrowski patent, the Examiner acknowledges that the Dabrowski patent lacks disclosure of allowing the player to select background colors for replacement. The Manship patent discloses a slot machine game having display colors. In a so-called "Fever Mode," Manship's display colors are enhanced and the payout table is changed (see, col. 5, lns. 13-41 and col. 7). In its Abstract, the Bennett patent discloses that when a certain combination of numerical symbols appears after the only spin (e.g., three 7's), the slot machine can then choose to backlight those symbols with different colors (e.g., red, white or blue) and change the payout depending on the backlit colors. Like other common slot machines, there is no provision in either the Manship nor the Bennett patents for allowing the *player* to select one or more symbols or colors for replacement after the initial spin. As such, both Manship's and Bennett's slot machines are entirely games of chance, whereas Applicant's respin slot machine involves an important element of skill (i.e., choosing which slot machine symbols or colors to replace). For these reasons, neither the Manship nor the Bennett patents provide the claimed disclosure missing from the Dabrowski patent.

Claims 20-30, 32, 34 and 36 have been rejected as being unpatentable over the Dabrowski patent or Heidel's U.S. Patent No. 5,342,047 ("Heidel patent") in view of the Manship patent. The deficiencies in the Dabrowski and Manship patents have already been discussed. Contrary to the Examiner's position, the Heidel patent disclosure proves, if anything, that Applicant's slot machine respin invention is *not* obvious. As noted by the Examiner, the Heidel patent discloses a typical video poker game with a *single* row of gaming cards, one which allows cards to be selected for replacement (i.e., by pressing buttons 32a-32e). The Heidel patent also discloses a video slot machine game in Fig. 2a. In describing this video slot machine game, Heidel parrots the conventional wisdom in the art prior to Applicant's invention that *one cannot have a respin capability on an electronic slot machine game*:

> "When a game other than poker, *such as the slot machine game of FIG. 2a*, is selected by the player, the computer 50 is programmed to not accept inputs from the control button circuit 74. *Touching the game control buttons 32a-32e will therefore have no effect on the game*" (Heidel patent, col. 3, lns. 43-47; emphasis added).

Since the Heidel patent strongly teaches away from Applicant's invention, it is clear that Heidel cannot be combined with Dabrowski and/or Manship to render Applicant's claims 20-30, 32, 34 and 36 as "obvious."

In the "*Examiner's Response to Applicant's Remarks*," the Examiner appropriately acknowledges that "the novel feature is that prior art slot machines do not have single symbol re-spin and replacement features." As previously noted, Applicant and the Examiner are in agreement on this point. To overcome the claim wording issues which have arisen, the Examiner helpfully suggests incorporating claim language regarding the "respin of symbols that are in separate boxes" in all of the independent claims and further changing the "none to all" feature to --at least one to all--.

While Applicant very much appreciates the effort the Examiner has made to suggest alternative claim wording, Applicant nonetheless respectfully submits that the wording proposed would not capture Applicant's true invention. For example, since the present invention is an *electronic* slot machine game, the symbols are not really "respun" in the sense of a mechanical wheel spinning. In Applicant's preferred game, the "respinning" process is accomplished electronically by the microprocessor randomly selecting replacement symbols from a list of possible symbols in the computer memory and then displaying the replacement symbols on the monitor. As such, it would be technically inaccurate to speak of "respinning" in Applicant's claim language.

Of potentially greater significance, Applicant believes that changing the "none to all" feature to --at least one to all-- in all of Applicant's claims, as the Examiner suggests, would be unduly limiting. More particularly, Applicant submits that while some slot machine prior art references allow a player to "nudge" a slot machine stepper reel or respin all, and only all, of the displayed symbols, none of the slot machine prior

art allowed the player to individually pick and choose from Applicant's *range* of replacement capabilities. At one end of the range, the player could chose no symbols for replacement. At the other end of the range, the player could choose all of the symbols for replacement. Between these ends, the player could choose many combinations of individual symbols for replacement. This "*freedom of choice*" is an important distinction between Applicant's invention and the prior art.

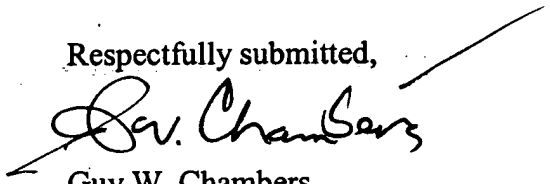
The Examiner correctly notes that if the player does not replace any of the initially drawn symbols, Applicant's game will behave much like a regular slot machine. Nonetheless, the important difference is that, in Applicant's game, the player has been given a *choice* he or she would not have in a regular slot machine game. As recited in Applicant's claims, the player in Applicant's game has been *allowed* to designate a chosen number, from none to all, of said initially displayed symbols for replacement. Applicant submits that the "freedom of choice" allowed by Applicant's slot machine is simply not present in any of the prior art slot machine games.

In the interest of expediting prosecution, though, Applicant has incorporated the Examiner's proposed "one to all" limitation into claims 31, 33 and 35 so that Applicant will be assured of at least some allowable subject matter even if the Examiner continues to disagree with Applicant's "none to all" claim limitation.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 576-0200.

Respectfully submitted,



Guy W. Chambers
Reg. No. 30,617

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
GWC:lcb
SF 1361654 v1